

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No.: 134687NV (MHM 15085US01)

PATENT

In the Application of:)
Peterson) **Electronically Filed On January 21, 2008**
Serial No.: 10/660,825)
Filed: September 12, 2003)
For: SYSTEM AND METHOD FOR) Examiner: Mehta, Parikha Solanki
DETERMINING THE POSITION OF A)
FLEXIBLE INSTRUMENT USED IN A) Group Art Unit: 3737
TRACKING SYSTEM) Confirmation No.: 7037

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reasons stated on the attached sheets.

Respectfully submitted,

Date: January 21, 2008 By: /Joseph M. Butscher
Joseph M. Butscher
Reg. No. 48,326
Attorney for Applicants

McANDREWS, HELD & MALLOY, LTD.
500 West Madison Street, 34th Floor
Chicago, Illinois 60661
Telephone: (312) 775-8000
Facsimile: (312) 775 – 8100

REMARKS

The present application includes pending claims 1-20, all of which were rejected. The Applicant notes that the amendments to the claims filed after final rejection do not “raise new issues” or “new matter.” *See December 27, 2007 Advisory Action.*

Claims 1-6 stand rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent No. 4,722,348 (“Ligtenberg”). Claims 7-20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ligtenberg in view of United States Patent No. 5,803,089 (“Ferre”).

The Applicant respectfully submits that the final Office Action fails to establish a *prima facie* case of anticipation or obviousness with respect to the pending claims for a variety of reasons. *See December 6, 2007 Amendment at pages 6-12.*

First, the Applicant demonstrates that Ligtenberg does not anticipate claims 1-6. *See id.* at pages 6-8. Ligtenberg does not describe, teach or suggest “wherein said strain gauge **detects deflection** of said flexible engaging member, wherein the detection of deflection of said flexible engaging member **provides information regarding a location of said operative tip**,” as recited in claim 1. *See id.* Such limitations are nowhere to be found in Ligtenberg. *See id.* Indeed, the final Office Action seems to acknowledge as much. *See November 23, 2007 Office Action at page 2* (“One could certainly argue that by sensing the external pressure with the reference transducer, one can infer information regarding the location of the device.”). Cleary, if one needs to “argue” and “infer information” from portions of Ligtenberg (as opposed to merely pointing to where such information is disclosed) to reject a claim, a *prima facie* case of anticipation has not been established. *See December 6, 2007 Amendment at pages 6-8.*

Additionally, the Office Action makes summary conclusions regarding what is disclosed in Ligtenberg. *See id.* at page 8 (citing November 23, 2007 Office Action at page 2). However, none of those summary conclusions are disclosed in Ligtenberg; once again demonstrating that the final Office Action fails to establish a *prima facie* case of anticipation with respect to claims 1-6. *See id.* at pages 8-9.

Further, the final Office Action does not provide any factual evidence for the summary conclusions noted above (e.g., that blood pressure detection provides information of a catheter tip position). *See id.*

Indeed, the Applicant perceives that the final Office Action is asserting Official Notice of the subject matter of the statements. *See id.* The Applicant traversed the perceived assertions of Official Notice. *See id.* at pages 9-11. In particular, the Applicant challenged the following: 1.) “[O]ne could certainly argue that by sensing the external pressure with the reference transducer, one can infer information regarding the **location of the device**,” and 2.) “[I]t is known in the art that the pressure of flowing blood varies predictably within the cardiovascular system, and **therefore the sensed pressure can indeed provide information regarding the catheter’s location within the patient.**” *See id.* at pages 9-11. Again, these unsupported conclusions are nowhere to be found in Ligtenberg. *See id.* at pages 6-9. Therefore, as noted above, the Office Action fails to establish a *prima facie* case of anticipation with respect to claims 1-6.

The Advisory Action provides, however, copies of website pages **dated December 12, 2007** that note “normal pressure” within a “normally functioning heart with no fluid accumulation.” *See* December 27, 2007 Advisory Action at page 2. Initially, the Advisory Action has not established that the copies of the website pages are prior art with respect to the

present application. Moreover, there is nothing in these website pages that indicates that **Ligtenberg** describes, teaches or suggests the following: 1.) “by sensing the external pressure with the reference transducer, one can infer **information regarding the location of the device**,” and 2.) “[I]t is known in the art that the pressure of flowing blood varies predictably within the cardiovascular system, and **therefore the sensed pressure can indeed provide information regarding the catheter’s location within the patient.**” Again, the copies of the website pages dated December 12, 2007 merely note “normal pressure” within a “normally functioning heart with no fluid accumulation.” For this additional reason, the Applicant respectfully submits that the final Office Action fails to establish a *prima facie* case of anticipation with respect to the claims 1-6.

The Examiner seemingly acknowledges that the newly cited reference does not prove that **Ligtenberg** describes, teaches or suggests the limitations. *See* December 12, 2007 Advisory Action at page 2 (“Should Applicant require additional evidence supporting the assertion..., Examiner is willing to submit upon request an affidavit as a former employee of Medtronic, Inc. to assert that it is widely known that fluid pressure varies predictably within the human cardiovascular.”). Instead, the Examiner seems to base the conclusions on personal knowledge acquired as “a former employee of Medtronic,” and only to the extent that “fluid pressure varies predictably within the human cardiovascular,” but not that a catheter tip position is therefore known. *See id.*

Next, the Applicants respectfully submit that Ligtenberg does not describe, teach or suggest a “strain gauge affixed to a portion of said flexible engaging member, ... wherein said flexible engaging member is one of a needle, catheter, curette, and K wire,” as recited in claim 4.

The final Office Action does not cite anything in Ligtenberg that discloses such limitations. *See* November 23, 2007 Office Action at page 3. Indeed, the final Office Action does not even attempt to offer a citation from Ligtenberg as disclosing these limitations. *See id.* Thus, for at least this additional reason, the Office Action has not established a *prima facie* case of anticipation with respect to claim 4.

The Applicants also respectfully submit that the proposed combination of Ligtenberg and Ferre does not render claims 7-20 unpatentable, and that the final Office Action does not establish a *prima facie* case of obviousness with respect to these claims. *See id.* at page 12.

Further, the Office Action does not demonstrate that either Ligtenberg or Ferre discloses “using a second tracking method to track deflections of an operative tip of the medical instrument,” as recited in claim 14. *See id.* at page 12. Indeed, the final Office Action does not even attempt to offer a citation from either reference as disclosing this limitation. *See* November 23, 2007 Office Action at pages 3-4. Thus, for at least this additional reason, the Office Action does not establish a *prima facie* case of obviousness with respect to claims 14-20.

For at least the reasons discussed above, the Applicant respectfully request review of the final Office Action.

The Commissioner is authorized to charge the \$510 fee for the Notice of Appeal and any other necessary fees, or credit any overpayment to Deposit Account 50-2401.

Respectfully submitted,

Date: January 21, 2008

/Joseph M. Butscher/
Joseph M. Butscher
Registration No. 48,326
Attorney for Applicant

MCANDREWS, HELD & MALLOY, LTD.
500 West Madison Street, 34th Floor
Chicago, Illinois 60661
Telephone: (312) 775-8000
Facsimile: (312)775-8100